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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | Docket Number (Optional) 058268.00137 |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____ | Application Number: 09/886,859 |
| | Filed: June 21, 2001 |
| | First Named Inventor: Hoang T. TRAN et al. |
| | Art Unit: 2116 Examiner: Paul B. YANCHUS III |

Mail Stop AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

- ☒ Attorney or agent of record.
Registration No. 54,749

- ☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____

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April 30, 2007

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- ☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Hoang T. TRAN

Art Unit: 2116

Application No.: 09/886,859

Examiner: Paul B. YANCHUS III

Filed: June 21, 2001

Attorney Dkt. No.: 058268.00137

For: METHOD AND APPARATUS FOR REGULATING TRANSCEIVER POWER
CONSUMPTION FOR A TRANSCEIVER IN A COMMUNICATIONS NETWORK

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

April 30, 2007

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-24 in the above identified application. Claims 1-24 were finally rejected in the Office Action dated January 29, 2007. Applicants filed a Response to the Final Office Action on March 27, 2007, and the Office issued an Advisory Action dated April 24, 2007 maintaining the final rejections of claims 1-24. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

The final Office Action rejected claims 1-5, 11-17, and 23-24 under 35 U.S.C. §102(e) as being anticipated by Bar-Niv (U.S. Patent No. 6,442,142). Applicants submit that there is clear error with regard to the anticipation of at least one element of claims 1 and 13, upon which claims 2-12 and 14-24 are dependent.

Applicants respectfully submit that the present claims recite subject matter which is neither disclosed nor suggested by Bar-Niv, and that, therefore, the final rejections are clearly improper and without basis. Specifically, Bar-Niv fails to disclose or suggest, at least, "wherein the transceiver state machine includes a wake-up control and a power down control, the wake-up

control being configured to send power control signals to a transmitter and the power down control being configured to send power control signals to all components of the transceiver,” as recited in claims 1 and 13.

In the response to arguments section, the final Office Action took the position that the energy-on state machine and power module of Bar-Niv together act as a wake-up control and power-down control for the transceiver (final Office Action, page 8). In other words, the Office Action appears to have taken the position that the power module of Bar-Niv corresponds to the wake-up control of the present invention and that the ENERGYON signal of Bar-Niv corresponds to the power down control of the present invention. However, Applicants respectfully disagree for at least the following reasons.

Bar-Niv merely discloses that the power module receives the ENERGYON signal and, responsive thereto, supplies power to operate modules of the device (Bar-Niv, Column 2, lines 41-43). In other words, Bar-Niv teaches that the power module receives an ENERGYON signal and, based on the level of that signal, supplies power to the transceiver circuitry or powers down the transceiver circuitry.

The present claims, on the other hand, recite a first element (the wake-up control) which sends power control signals to a transmitter and another element (the power down control) which sends power control signals to all components of the transceiver. According to embodiments of the present invention, both a wake-up control and power down control are provided. The wake-up control, included in the transceiver state machine of the present invention, sends power control signals to a transmitter. The power down control of the present invention sends power control signals to all components of the transceiver, except the transmitter and signal detection. The power control signal being sent is automatically determined in response to the presence or absence of an energy detect signal (Specification, Page 8, lines 17-27).

Bar-Niv, as discussed above, merely teaches the use of a power module that powers down or powers up the transceiver circuitry based on the ENERGYON level. Nowhere does Bar-Niv disclose a control which sends power control signals to a transmitter and a control which sends power control signals to all components of the transceiver. Rather, Bar-Niv only discloses a power module that supplies power to the transceiver circuitry when the ENERGYON signal is at level 1 (Bar-Niv, Column 4, lines 15-16 and Column 6, line 30). The Office Action asserts that

the transceiver circuitry would inherently include some type of transmitter (Office Action, page 8). Applicants note that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Bar-Niv teaches that the transceiver circuitry includes “a link monitor 34, and an autonegotiation mechanism 36. The autonegotiation mechanism selects an operating mode of the transceiver, as explained in the Background of the Invention. Link monitor 34 checks for link signals on communication line 14. If link signals are present, monitor 34 generates a LINK_ON signal. If link signals are not present, monitor 34 generates a LINK_OFF signal” (Bar-Niv, Column 4, lines 17-25). Bar-Niv does not disclose, either inherently or expressly, that the transceiver circuitry includes a transmitter. As such, Bar-Niv fails to disclose a wake-up control which sends power control signals to a transmitter.

Moreover, Bar-Niv clearly fails to disclose or suggest a transceiver state machine which includes a wake-up control or a power-down control. More specifically, Bar-Niv does not disclose a wake-up control that sends power control signals to a transmitter and a power down control that sends power control signals to all components of the transceiver. Bar-Niv merely discloses that “when the ENERGYON signal is at level 1, module 30 supplies power to transceiver circuitry 32. When the ENERGYON signal is at level 0, module 30 powers down circuitry 32” (Bar-Niv, Column 6, lines 29-32). Neither the power module nor the ENERGYON signal of Bar-Niv correspond to the wake-up control and power down control of the present invention. The present claims specifically recite that the wake-up control sends power control signals to a transmitter, while the power down control sends power control signals to all components of the transceiver. Bar-Niv does not disclose or suggest a wake-up control that sends power control signals to a transmitter nor does it disclose or suggest a power down control that sends power control signals to all components of the transceiver, except the transmitter and signal detection. Bar-Niv only discloses a single module which powers down the entire transceiver circuitry when the ENERGYON signal is at 0.

Therefore, Applicants respectfully submit that Bar-Niv fails to disclose or suggest all of the elements of claims 1 and 13 and that, therefore, the final rejections are improper and without

basis. As such, Applicants respectfully request that the rejection of claims 1 and 13 be withdrawn.

Applicants submit that claims 2-5 and 11-12 are dependent upon claim 1, while claims 14-17 and 23-24 are dependent upon claim 13. Thus, claims 2-5, 11-12, 14-17, and 23-24 should be found allowable for at least their dependence upon claims 1 and 13, respectively, and for the specific limitations recited therein.

Claims 6-10 and 18-22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bar-Niv, in view of Uppunda (U.S. Patent No. 6,678,728). Applicants note that claims 6-10 and 18-22 are dependent upon claims 1 and 13, respectively. In addition, as stated above, Bar-Niv does not disclose or suggest all of the elements of independent claims 1 and 13. Applicants submit that there is clear error with regard to the combination of the cited references teaching all the recitations of independent claims 1 and 13. Applicants submit that Uppunda, like Bar-Niv, also fails to disclose or suggest a transceiver state machine that includes at least one of a wake-up control and a power down control. As such, Uppunda fails to cure the deficiencies in Bar-Niv discussed above. Consequently, the combination of Bar-Niv and Uppunda fails to disclose or suggest all of the elements of claims 6-10 and 18-22 which are dependent upon claims 1 and 13, respectively. Furthermore, applicants respectfully submit that claims 6-10 and 18-22 should be found allowable for at least their dependence on claims 1 and 13, respectively, and for the specific limitations recited therein.

For at least the reasons discussed above, Applicants respectfully submit that the present claims recite subject matter which is neither disclosed nor suggested by Bar-Niv and Uppunda, and that, therefore, the final rejections are clearly improper and without basis. It is therefore respectfully requested that all of claims 1-24 be allowed, and this application passed to issue.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form
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